

### REMARKS-General

The newly drafted independent claim 14 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 14-19 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

With regard to the rejection of record based on prior art, Applicant will advance arguments to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the prior art of record. Reconsideration of the present application is requested.

#### Response to Rejection of Claims 9-13 under 35USC112

The applicant submits that the newly drafted claims 14-19 particularly point out and distinctly claim the subject matter of the instant invention, as pursuant to 35USC112.

#### Response to Rejection of Claims 6-13 under 35USC103

The Examiner rejected claims 6, 8, 9, 11 under 35USC103(a) as being unpatentable over Niira et al. (US 4,938,958). Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole**

and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Niira which is qualified as prior art of the instant invention under 35USC102(b) are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

The applicant respectfully submits that the differences between the instant invention and Nirra are not obvious under 35USC103(a), due to the following reasons:

**(A)** Regarding the newly drafted claim 14, Niira fails to anticipate a method for preparing an inorganic antibacterial agent containing high-valence silver, comprising the steps of: adding a solid carrier, which is capable of ion exchange, into a solution containing high-valence silver, wherein a volume ratio between said solid carrier and said solution containing high-valence silver is between **1:6 and 1:10**; substantially stirring said solution to obtain a pulp formed solution for enabling an ion exchange reaction between said high-valence silver ion and the exchangeable ion of said solid carrier to yield a solid compound; and filtering and drying said solid compound to ultimately obtain said inorganic antibacterial agent containing high valence silver.

**(B)** Nirra generally discloses an antibiotic resin composition which comprises a resin from 0.05 to 80 wt% of an antibiotic zeolite in which all or a part of ion-exchangeable ions in said zeolite are replaced with antibiotic metal ions comprising silver ions and with ammonium ions, and amount of silver ions ranging from 0.1 to 15wt% and the amount of ammonium ions ranging from 0.5 to 15wt%. In other words, Nirra fails to specifically mention that the volume ratio between said solid carrier and said solution containing high-valence silver is between **1:6 and 1:10**.

**(C)** The examiner is of the view that it would have been obvious for one having ordinary in the art to perform the method of producing a silver antibiotic agent found in Col. 2 Line 58 to Col. 3, Line 61 of Niira with the steps of stirring the solution and filtering the product in order to produce the instant invention. The applicant respectfully disagrees. In the Office Action itself, the examiner concedes that Nirra does not teach or suggest the specific embodiment of the methods of producing antibiotic materials as well as the claimed steps in the instant invention. Indeed, the applicant

respectfully submits that Nirra fails to suggest, motivate or teach the specific embodiments, steps and the weight and volume ratios of specific ingredients as claimed in the newly drafted independent claim 14, or at least the limitations set forth in claims 15-19.

(D) The Examiner appears to reason that since Nirra teaches a resin composition which is functionally similar to the one disclosed in the instant invention, it would have been obvious to one skilled in the art to modify Nirra in order to produce the specific embodiments of the instant invention. But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. *See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In the present case, there is no such suggestion. The applicant respectfully submits that, in chemical compositions and methods inventions, differences in volume ratio or weight often would have a substantially unexpected result in the form of an improved performance of the same or similar function. But this result can hardly be said to be obvious in light of prior arts.

(E) The applicant respectfully submits that to reject claims in a patent application under 35 U.S.C. 103, the Examiner must show an unrebutted prima facie case of obviousness. See *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995).

A prima facie case of obviousness requires setting forth:

- (a) the differences in the claim over the applied references,
- (b) the proposed modification of the applied references necessary to arrive at the claimed subject matter, and
- (c) an explanation why such proposed modification would be obvious. MPEP §706.02.

The applicant respectfully submits that the examiner fails to explain why modification based on Nirra is obvious.

(F) "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." *Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103 (DCNJ 1987). In hindsight, the Examiner may feel that it would be obvious to modify Nirra to the instant invention because they are similar compositions, yet such hindsight reconstruction is not a permissible method of constructing a rejection under 35 U.S.C. 103. *In re Warner and Warner*, 154 USPQ 173, 178 (CCPA 1967), especially when the method was not explicitly disclosed in Nirra.

(G) Regarding claim 18, Nirra fails to suggest, motivate or teach that the ion exchange reaction between the high-valence silver and the solid carrier is reacted at a predetermined condition, wherein a pH value is ranged **between 1 and 5**, and a temperature ranged between **30 degrees Celsius and 80 degrees Celsius**, a reacting time ranged **between 2 hours to 8 hours**, wherein the PH value is adjust by applying one of **20% NaOH and 20% KOH**.

(H) Moreover, regarding claim 20, Nirra fails to anticipate that the method comprises a step for calcinating the solid compound **between 800 degree Celsius and 1000 degree Celsius**, for a time between **2 hours to 4 hours**, and a step for grinding the solid compound by a gas flow pulverizer to obtain particles with a size of average diameter between **1.0m.um. to 10.0mu.m**.

The Examiner also rejected claims 8, 10 and 12 under 35USC103(a) as being unpatentable over Niira et al. (US 4,938,958) in view of Ohsumi et al. (US 5,441,717). The applicant respectfully submits that the differences between the instant invention and

Nirra are not obvious in view of Ohsumi et al. under 35USC103(a), due to the following reasons:

(I) Regarding the newly drafted claim 16, Nirra and Ohsumi et al. fail to anticipate that the solid carrier is selected from a group consisting of sodium zirconium phosphate, titanium phosphate, tin phosphate and zeolite, in addition to what is claimed in the newly drafted independent claim 14 as a whole.

(J) Regarding the newly drafted claim 17, Nirra and Ohsumi et al. fail to anticipate that wherein the ion exchange reaction between the high-valence silver and the solid carrier is reacted at a predetermined condition, wherein a pH value is ranged between 1 and 5, and a temperature ranged between 30 degrees Celsius and 80 degrees Celsius, a reacting time ranged between 2 hours to 8 hours, wherein the PH value is adjust by applying one of 20% NaOH and 20% KOH, in addition to what is claimed in the newly drafted independent claim 14 as a whole.

(K) Regarding the newly drafted claim 19, Nirra and Ohsumi et al. fail to anticipate that the method further comprises a step for calcinating the solid compound between 800 degree Celsius and 1000 degree Celsius, for a time between 2 hours to 4 hours, and a step for grinding the solid compound by a gas flow pulverizer to obtain particles with a size of average diameter between 1.0m.um. to 10.0mu.m, in addition to what is claimed in the newly drafted independent claim 14 as a whole.

(L) For claims 16-17 and 19, even combining Nirra and Ohsumi et al. would not provide the invention as claimed -- a clear indicia of nonobviousness. Ex parte Schwartz, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). That is, modifying Nirra with the teaching disclosed in Ohsumi et al., as proposed by the Examiner, would not provide the instant invention because neither Nirra nor Ohsumi (and a combination of both) disclose the particular embodiment recited in claim 14 of the instant invention. Indeed, the only mention of the specific embodiments of the method is in applicants own specification and claims. Accordingly, it appears that the Examiner has fallen victim to the insidious effect of a hindsight analysis syndrome where that which only the inventor taught is used against the teacher in W.L. Gore and Associates v. Garlock, Inc., 220 USPQ 303, 312-313 (Fed. Cir. 1983) cert. denied, 469 U.S. 851 (1984).

Regarding all claims: kindly carefully reexamine all claims in light of all references of record. It is the Applicant's view that while prior references exist (e.g., as in Nirra and Ohsumi et al.), if one puts the claimed invention out of mind and reviews all of these references for all that they fairly suggest, one would not find any motivation to modify the references of record to thereby attain the claimed invention, which relates to a method of **preparing an inorganic antibacterial agent** which are specifically configured (with specific embodiments and weights and volume ratio to each of very composition) to provide a particularly advantageous results. While an antibacterial agent in general may be known and/or suggested, the particular claimed configurations are not.

Moreover, where a claimed relationship between variables or parameters is not discussed or suggested by a prior art reference, such reference cannot render such relationship of variables obvious unless such variables (i.e. the specific embodiment and compositions of the method disclosed by the instant invention) are inherent. See *In re Rejckaert*, 9F.3d 1531 (Fed. Cir. 1993). There is no such inherent nature in the instant invention.

Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

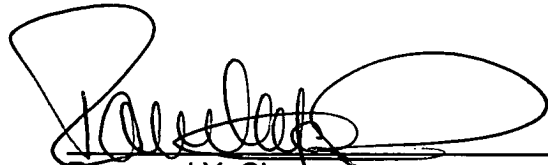
#### **The Cited but Non-Applied References**

The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 14-19 at an early date is solicited.

Should the examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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### CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

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